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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/533,620	04/18/2006	Heinz Zimmerman	LAGP:116US	1763
24041 7590 05/30/2008 SIMPSON & SIMPSON, PLLC 5555 MAIN STREET WILLIAMSVILLE, NY 14221-5406				
EXAMINER NGUYEN, THONG Q				
ART UNIT 2872		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/533,620

**Applicant(s)**

ZIMMERMAN ET AL.

**Examiner**

Thong Nguyen

**Art Unit**

2872

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 2 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 29 April 2005 and 22 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☒ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 28, 29, 32-44 and 47-59 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☒ Claim(s) 28, 29, 32-44 and 47-59 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 29 April 2005 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date 9/30/05
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Response to Amendment***

1. The present Office action is made in response to the pre-amendment filed on 4/29/05 and the Election and amendment filed on 1/22/08.
2. It is noted that in the pre-amendment of 4/29/05, applicant has made changes to the abstract, the specification and the claims. Regarding to the claims, applicant has canceled all original claims 1-27 and added a new set of claims, i.e., claims 28-58, into the application. It is also noted that applicant has submitted a substitute specification with its marked-up to show the changes to the specification.
3. The newly-added claims 28-58 were subjected to a restriction requirement. In response to the restriction requirement of 12/17/07, applicant has filed an election to elect the invention II with traverse and also filed an amendment to make changes to the claims. In particular, applicant has amended claims 28-29, 38, 47, 49-54; canceled claims 30-31 and 45-46 and added a new dependent claim, i.e., claim 59 into the application. There is not any change to the drawings and the specification provided in the amendment of 1/22/08.

### ***Election/Restrictions***

4. Applicant's election with traverse of Invention II claims 31-44 and 51-58 in the reply filed on 1/22/08 is acknowledged. The traversal is on the ground(s) that the inventions are related to the same technical feature with all optical elements being arranged to make the illumination of a microscope being functional. It is also noted that applicant has amended the linking claim 28 by adding features of illuminating system.

After further review the claims as amended, the restriction requirement is now withdrawn and all pending claims 28-29, 32-44 and 47-59 are examined in this office action.

***Information Disclosure Statement***

5. The information disclosure statement filed on 9/30/05 fails to comply with 37 CFR 1.98(a) (2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered.

*In particular, applicant has failed to provide a copy of the foreign reference EP 816 893. Applicant has just provided an English abstract of the mentioned reference, not a complete copy of the foreign reference EP 816 893.*

6. The listing of references in the specification is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and MPEP § 609.04(a) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

*In particular, the listing of the foreign reference no. EP A1 1010030, see paragraphs [0010], [0027], and [0035]-[0036] is not a proper information disclosure statement.*

***Priority***

7. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

***Drawings***

8. The drawings contained seven sheets of figures 1-9 were received on 4/29/05. These drawings are objected by the examiner for the following reasons.

9. The drawings are objected to because of the following problems: First, in each of figures 6 and 8, it is unclear about the terms "0,5 SB", and in fig. 7, it is unclear about the term "0,25 SB"; and Second, figure 8 contains some foreign language. Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the

applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

10. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the feature related to an adjustable system for adjusting the lens as recited in claim 41 and the feature related to an adjustable mirror as recited in claim 48 must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***.Specification***

11. The substitute specification filed on 4/29/05 has been entered.
12. The abstract of the disclosure is objected to because the term "said" is sued and it longs more than 150 words. Correction is required. See MPEP § 608.01(b).

Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

13. The lengthy specification which was amended by the amendment of 4/29/05 has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.

14. The disclosure is objected to because of the following informalities: a) It is noted that while the substitute specification filed by applicant on 4/29/05 has been entered; however, in the clean version of the substitute specification, there is still contained some marked-up changes as can be seen in paragraphs [0002], [0004], and [0011]. Applicant should correct the mentioned paragraphs in response to this Office action; b) The specification does not provide a detailed description of figure 9. Appropriate correction is required.

15. The specification is objected to as failing to provide proper antecedent basis for the claimed subject matter. See 37 CFR 1.75(d)(1) and MPEP § 608.01(o). Correction of the following is required: The specification has not positively provided an antecedent basis for each of the following claimed features.

First, the arrangement among the components into a single unit as recited in claim 38 does not have a proper antecedent basis in the specification. Applicant is respectfully invited to review the specification, in particular, paragraph [0014] which discloses that the holder (14), the gear (10), the carrier (12), the switching device (5) and the beam splitter (2a) are arranged into a single unit. The specification does not disclose that the holder (14), the gear (10), the carrier (12), the switching device (5), the beam splitter (2a) and the illumination coupling-in device are arranged into a single unit as claimed in claim 38.

Second, the specification does not provide a proper antecedent basis for the feature related to the compound lens structure as recited in claim 39, lines 1-4.



Third, the specification does not provide a proper antecedent basis for the feature related to the adjustable system for adjusting the compound lens (7) as recited in claim 41.

Fourth, the specification does not provide a proper antecedent basis for the feature related to stereo lens structure as recited in claim 42, lines 1-3.

Fifth, the specification does not provide a proper antecedent basis for the feature related to the connection between the short part of the "L" holder and the focus adjusting mechanism as recited in claim 44, lines 2-3.

Sixth, the specification does not provide a proper antecedent basis for the adjustable characteristic of the mirror 942) as recited in claim 48.

Seventh, the specification does not provide a proper antecedent basis for the feature related to the parallel feature of the flat component and the so-called "beam splitter surface" as recited in claim 52, lines 2-3.

### ***Claim Objections***

16. Claim 58 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form.

17. Claims 28-29, 32-44 and 47-59 are objected to because of the following informalities. Appropriate correction is required.

a) In claim 28: the following corrections are suggested to the claim.

First, the use of the terms for reference "(Vs)" is not consistent. In particular, on line 13, applicant has used the term "distance" for the reference Vs; however, on each of lines 18-19 and 25, applicant has used the term "displacement" for the reference Vs. It is also noted that the term "displacement" is used in dependent claim 32. Should the term "distance" appeared on line 13 be changed to --displacement-- to make the claim comply with the requirement of 35 USC 112, second paragraph?

It is also noted that applicant has used the term "misalignment" for the same term Vs as can be seen in claim 57, line 4. It is also suggested that applicant amend claim 57 so that the use of term for reference Vs is consistent for all claims.

Second, on line 20, "holder" should be changed to --said holder--; and

Third, on line 20, "the lenses" should be changed to --each of the lenses--.

b) In claim 29: on line 1, "an incident light illumination system" should be changed to --said incident light illumination system--. See claim 28, line 4.

c) Claims 34 and 55 are objected to because each of the claims includes reference characters which are not enclosed within parentheses.

First, in claim 34: on each of lines 2 and 3, the terms "3a, 3b" should be changed to --(3a, 3b)--;

Second, in claim 55, on each of lines 4 and 5, the terms "3a, 3b" should be changed to --(3a, 3b)--;

Third, in claim 56: on line 2, "5" should be changed to --(5)--.

d) In claim 35: on line 1: the term "a)" should be deleted.

e) in claim 38: on line 3, the term "device" should be changed to --system--. See claim 28, on lines 15-16.

f) In claim 40: on line 1, "Stereomicroscope" should be changed to --A stereomicroscope--.

g) In each of claims 41 and 43: on line 2 of each claim, the term "preferably" should be deleted.

h) In claim 47: on line 1, the term "device" should be changed to --system--. See claim 28, lines 15-16; and on line 2, "and/or" should be changed to --and--. See specification, paragraph [0046] and fig. 4.

i) In claim 48: on line 2, "device" should be changed to --system--.

j) In each of claim 53 and 54: the feature thereof "the first beam splitter" appeared on lines 1-2 of each claim does not have a proper antecedent basis. Applicant is respectfully invited to review the device of claim 28, lines 9. Should the terms "a beam splitter" appeared on line 8 of claim 28 be changed to --a first beam splitter-- to make each of claims 53 and 54 comply with the requirement of 35 USC 112, second paragraph?

k) In claim 59: the dependent status of claim 59 is unclear. Applicant should note that a claim cannot depend on itself. Should claim 59 be amended to depend upon claim 28?

l) The remaining claims are dependent upon the objected base claims and thus inherit the efficiencies thereof.

***Allowable Subject Matter***

18. Claims 28-29, 32-44, 47-57 and 59 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action.

19. The following is a statement of reasons for the indication of allowable subject matter:

The stereomicroscope as recited in the independent claim 28 is patentable with respect to the prior art, in particular, the Pub. No. 2002/0034001 and the U.S. Patent Nos. 6,930,828; 4,697,893 and 5,349,468 by the limitations related to the structural relationship among the beam splitter for combination two stereoscope observation beam paths, the system for coupling an illuminating beam path, a carrier bearing the microscope body, a switching device and a gear for automatically displace the carrier to compensate a displacement between the emerging beam path of the beam splitter with respect to the symmetric axis of the two observation beam paths as recited in the claim. It is noted that the use of a beam splitter, a switching device, a carrier and a mechanism having gear for displacement the carrier is disclosed in the mentioned Publication and the use of an illuminating system for coupling light onto an objective lens is disclosed in the Patent No. 5,349,468; however, the cited art does not suggest a combination of optical elements and their mechanical supports for meeting the device as claimed.

**Conclusion**

20. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

21. This application is in condition for allowance except for the following formal matters:

See the objections to the drawings, the specification and the claims as set forth in this Office action.

Prosecution on the merits is closed in accordance with the practice under *Ex parte Quayle*, 25 USPQ 74, 453 O.G. 213, (Comm'r Pat. 1935).

A shortened statutory period for reply to this action is set to expire **TWO MONTHS** from the mailing date of this letter.

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thong Nguyen whose telephone number is (571) 272-2316. The examiner can normally be reached on M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephone B. Allen can be reached on (571) 272-2434. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 2872

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Thong Nguyen/

Primary Examiner, Art Unit 2872